

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT

This Amendment responds to the Notice of Non-Compliant Amendment dated January 7, 2009; that Notice objected to the Amendment filed on December 12, 2008, on grounds the text of the withdrawn claims (55-86) was omitted.

This submission rectifies the point discussed in the Notice. The text of claims 55-86 has been presented. Any inconvenience caused by this inadvertent error is regretted.

This Amendment is otherwise identical in substance to the December 12 Amendment.

REMARKS

Claims 44-86 are pending in this application. Claims 1-43 have been cancelled. Claims 54-86 have been withdrawn from consideration. Claims 44-53 stand rejected. Claim 44 is independent. Applicants respectfully request consideration of claims 44-53 in light of the remarks that follow.

Objections to the Specification

Page 3 of the June 13, 2008 Office Action states that the specification is objected to because the priority data should be updated. In order to expedite the prosecution of the subject application, and without conceding either the correctness of the Office Action's position or the need for amendment for patentability reasons, Applicants have added a new paragraph stating the correct priority data for the subject application. No new matter has been added. Applicants respectfully request that this objection be withdrawn.

Page 3 of the Office Action states that Figures 3, 6, 9 and 10 have multiple figures and requested appropriate correction. In order to expedite the prosecution of the subject application,

and without conceding either the correctness of the Office Action's position or the need for amendment for patentability reasons, Applicants have replaced Drawing Sheets 3, 5, 7, and 8 to amend the figure labels accordingly. No new matter has been added. Applicants respectfully request that this objection be withdrawn.

Page 4 of the Office Action also states that the disclosure is objected to because it contains an embedded hyperlink directed to Internet addresses. In order to expedite the prosecution of the subject application, and without conceding either the correctness of the Office Action's position or the need for amendment for patentability reasons, Applicants have amended paragraph [0013] of the specification to remove the embedded Internet addresses. Applicants respectfully submit that no new matter has been added, but that material that had been incorporated is now directly recited in the specification. Applicant submit that this material is not essential. Applicants respectfully request that this objection be withdrawn.

35 U.S.C. § 102(e) Rejections

Page 4 of the Office Action states that claims 44-53 are rejected under 35 U.S.C. § 102(e) as being anticipated by Schubert et al (Pub. No. US 2004/0106539) (the "'539 Application").

Applicants respectfully submit that the Section 102(e) rejection should not be maintained. The invention claimed in independent claim 44 of the subject application and described in the '539 Application were not invented by "another" as is required under Section 102(e). Rather, they were invented by the same inventor, namely Ulrich Schubert. See paragraphs 5-7 of the Declaration of Ulrich Schubert (Schubert Declaration) attached at Appendix 1. Moreover, Mr. Schubert invented this material prior to the filing date of the '539 Application. Schubert ¶¶ 7. Mr. Schubert is one of the inventors of the '539 Application and one of the inventors of the

subject application. Schubert ¶¶ 1 and 4. The invention of an agent comprising at least one proteasome inhibitor for use in inhibiting at least one of release, maturation and replication of members of the Flaviviridae family was invented by him. Schubert ¶¶ 5-7. Thus, the prior application does not represent the disclosure of “another”.

Applicant’s own work may not be used against him or her in a rejection based on 35 U.S.C. § 102(e). *In re DeBaum*, 687 F.2d 459, 462 (C.C.P.A. 1982) (citing *In re Katz*, 687 F.2d 450 (C.C.P.A. 1982) and MPEP 2136.05. Accordingly, when the unclaimed subject matter of a reference is applicant’s own invention, applicant may overcome a *prima facie* rejection under § 102(e) based on the U.S. patent application publication by showing that the disclosure is a description of applicant’s own work. MPEP 2136.05. The showing can be made by submission of an affidavit by the inventor under 37 CFR 1.132. *Id.* In addition, when the reference reflects applicant’s own work, applicant need not prove diligence or reduction to practice to establish that he or she invented the subject matter disclosed in the reference. Rather, Declarant’s statement that he invented the subject matter cited against him is enough to overcome the 35 U.S.C. § 102(e) rejection. *Id.* Accordingly, because Mr. Schubert confirms that he invented the subject matter cited against him, the rejection under § 102(e) must be withdrawn. MPEP 2136.05.

Applicants respectfully submit that it is immaterial that the Declaration is by only one inventor. The “other patentees need not submit an affidavit disclaiming inventorship.” *In re DeBaum*, 687 F.2d 459, 462 (C.C.P.A. 1982) and MPEP 2136.05. Applicants have not asserted that inventor Schubert invented every feature of every claim. Thus, it is sufficient that inventor Schubert invented the subject matter of independent claim 44 to overcome the rejection.

However, he need not have invented every aspect of every claim to overcome the § 102(e) rejection.

In *In re De Baun*, a prior patent issued to DeBaun and Noll was used to reject a subsequent application to DeBaun and Noll. *In re DeBaun*, 687 F.2d 459, 460 (C.C.P.A. 1982). DeBaun submitted a declaration stating that he invented the subject matter in the patent disclosure which disclosed the invention claimed in the subsequent pending application. *In re DeBaun*, 687 F.2d 459, 461 (C.C.P.A. 1982). In reversing the rejection, the CCPA found the declaration sufficient evidence to support the assertion that DeBaun invented the subject matter disclosed by the reference that was relied on to support the rejection. *In re DeBaun*, 687 F.2d 459, 463 (C.C.P.A. 1982). A declaration by Noll was not necessary to overcome the rejection. *In re DeBaun*, 687 F.2d 459, 463 (C.C.P.A. 1982).

Likewise, Applicants have submitted the Declaration of Mr. Schubert , which clearly states that he invented the subject matter disclosed in the '539 Application that was relied on to support the 35 U.S.C. § 102(e) rejection. Schubert ¶¶ 5-7. Accordingly, this is sufficient to overcome the 35 U.S.C. § 102(e) rejection and thus the rejection should be withdrawn.

It is also clear that Applicants can pre-date the reference. The information used by the patent attorneys to prepare the application being used against the pending claims was first invented by Mr. Schubert . Schubert ¶ 7. Therefore, Applicants clearly pre-date the reference.

For the reasons stated above, Applicants maintain that the statutory requirements of a U.S.C. § 102(e) rejection have not been met. Therefore, the 35 U.S.C. § 102(e) rejection of claims 44-53 should be withdrawn and, accordingly, notice that claims 44-53 are in condition for allowance is requested.

Applicant respectfully submits that this application is in condition for allowance. Early and favorable action is earnestly solicited. No fee is believed necessary in connection with the filing of this Response. However, if any additional fee is due the amount of such fee may be charged to Deposit Account No. 19-4709.

In the event that there are any questions, or should additional information be required, please contact applicants' attorney at the number listed below.

Respectfully submitted,



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